

### Remarks

Claims 1, 5, 6 and 12-15 are being examined on the merits. Claims 2-4, 7-11 and 16 have been previously canceled without prejudice. With this paper, Applicants respectfully submit amended Claim 1. No new matter is included with the amendment to Claim 1. Applicants further submit that amended Claim 1 is not anticipated by nor made obvious by U.S. Patent No. 3,365,315 (hereinafter, “Beck”), which is relied on by the Examiner for a rejection under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a). Applicants respectfully submit that while Beck teaches what *starting* material *may* be used for a glass composition, the reference *only* discloses the general ingredients for the starting material, as shown in TABLE 1. Beck does not teach the exact starting materials except as exemplified in Examples 1-5. Moreover, Beck does not make clear in any predictable manner what starting materials are always relied on. Applicants further point out that nowhere in Beck is there any teaching of the final glass composition once formed. Thus, the Examiner is comparing two entirely different compositions, a starting material as taught by Beck as compared with a formed product as claimed by Applicants. Certainly, Beck makes clear that the final material as taught by the Beck will be different than its starting material, but, again, there is no specific teaching anywhere in Beck as to what the final material actually is. The showing in Beck that the staring material is different from its formed product can be found in each of the Examples, such as when Beck describes the ingredients for the starting material and then recites very different ingredients in bubbles that reside in internal voids of the formed product (see, e.g., Example 1 comparing Col 6, ll. 27 and Col. 7, ll. 4-7). One of ordinary skill in the art, however, cannot decipher from an initial composition what the exact composition of the formed product will be, particularly when the temperature range and exact ingredients are not clearly or explicitly layed out and are not provided in an enabling manner. Only in the Examples of Beck is there any clear and concise and specific teaching as to what the exact starting materials are. This leads Applicants to point out that the very nature of Beck’s teaching is unpredictable, except those teachings provided in the Examples. Beck may suggest an abundance of ranges and ingredients which may be used to form glass particles, but such ranges cannot be relied on in any predictable manner when the

very teachings for the starting composition are vague and unreliable. The only reliable teachings of Beck are in Examples 1-5, which clearly show a starting material and that a starting composition differs from an end composition yet never makes clear what the final composition actually is. The Examiner is attempting to hold Applicants to an unpredictable teaching that does not even teach Applicants' claimed invention. Unless the Examiner can provide explicit secondary evidence that Beck teaches Applicants' formed product, Beck cannot be relied on for either a showing of anticipation or obviousness. This is because one of ordinary skill in the art cannot extrapolate from or readily anticipate the final composition in Beck from the list of suitable but not specific ingredients provided by Beck. More is required from Beck in order for the document to be reference that anticipates or makes obvious Applicants' claimed invention because it is not clear or obvious from the disclosure of Beck what the final product of Beck is. For these reasons, Applicants respectfully request the rejections relying on Beck under 102(b) or, in the alternative, under 35 U.S.C. § 103(a), be removed.

With respect to Amendments to the Specification as provided in a Supplemental Amendment submitted on February 7, 2008, Applicants respectfully point out that the amendment to the specification that began on page 2 of the paper should be directed to paragraph [0100] of the as-filed specification and that the amendment that began on page 3 of the paper should be directed to paragraph [0101] of the as-filed specification.

### **Conclusion**

In light of the foregoing, Applicants respectfully submit that the Application for patent is in condition for allowance, and pursuant to the filing of this Amendment, Applicants earnestly seek allowance of the claims, as provided in the Listing of Claims beginning on page 3 of this paper. Favorable consideration and allowance of the pending claims are therefore respectfully requested.

This paper is submitted concurrently with a Request for Continued Examination and the appropriate fees. To the extent that any further fees are required with this filing, the Commissioner is hereby authorized to charge payment of any additional fees to Deposit Account No. 07-0153 of Gardere Wynne Sewell LLP and reference Attorney Docket No. 129843-1104.

Should the Examiner have questions, comments, or suggestions in furtherance of the prosecution of this Application, please contact Applicants' representative at 214-999-4330. Applicants, through their representative, stand ready to conduct a telephone interview with the Examiner to review this Application if the Examiner believes that such an interview would assist in the advancement of this Application.

In the event that any additional time is needed for this filing, or any additional time in excess of that requested in a petition for an extension of time, please consider this a petition for an extension of time for any needed extension of time pursuant to 37 C.F.R. § 1.136 or any other section or provision of Title 37. Applicants respectfully request that the Commissioner grant the petition and authorize the Commissioner to charge the Deposit Account referenced above. Please credit any overpayments to this same Deposit Account.

This is intended to be a complete response to the Office Action mailed March 17, 2008.

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AMENDMENT AND RCE  
Application No. 10/648,009

8

Please direct all correspondence to the practitioner listed below at Customer No.  
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Dated: August 18, 2008

Respectfully submitted,



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